REMARKS

Claims 68, 69, 71, 73-86, and 111-116 are pending in the present application, and stand rejected. By the present amendment, claims 68, 69, 71, 73, 74, 76, 77, 81-84 and 111-116 have been amended. This application continues to include claims 68, 69, 71, 73-86, and 111-116.

Reconsideration of the rejections of claims 68, 69, 71, 73-86, and 111-116 is respectfully requested.

The Examiner cites numerous grounds for obviousness-type double patenting based on US 7,651,505. In an effort to further the prosecution of the present application, and without conceding the relevance of other secondary references cited by the Examiner in combination with US 7,651,505, submitted herewith is a terminal disclaimer directed to US 7,651,505. Applicants' representative is authorized to execute the terminal disclaimer based on the Power of Attorney and Statement Under 37 C.F.R. §3.73(b) filed on July 21, 2010, which was accepted by the Patent Office on July 30, 2010. Accordingly, it is respectfully requested that all rejections under obviousness-type double patenting based on US 7,651,505 be withdrawn.

Claims 68, 69, 71, 73-86, and 111-116 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite, as essentially reciting inconsistent terminology with respect to various recitations associated with a marker body. Also, claims 68 and 113 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for omitting essential structural cooperative relationships. Claims 68, 69, 71, 73, 74, 76, 77, 81-84 and 111-116 have been amended to address these rejections under 35 U.S.C. 112, second paragraph. Accordingly, it is respectfully requested that the rejections of claims 68, 69, 71, 73-86, and 111-116 under 35 U.S.C. 112, second paragraph, be withdrawn.

Claims 68, 69, 71, 113, 114 and 116 were rejected under 35 U.S.C. §103(a) as being unpatentable over Foerster, et al. (US 6,228,055; hereinafter Foerster) in view of Voegele, et al. (US 6,261,302; hereinafter Voegele) and Fulton III, et al. (US 6,270,464; hereinafter Fulton).

Independent claim 114 recites, in part, "a delivery cannula having ... a ramp within the distal shaft portion which is upwardly inclined to a distal portion of the elongated discharge port; b) at least one solid marker body slidably disposed within the inner lumen of the elongated shaft ...; and c) a plunger which is slidably disposed in part within the inner lumen of the delivery cannula proximal to the at least one solid marker body and detached from the at least one solid marker body, the plunger having a distal end configured to slidably engage and advance the at least one solid marker body from the location proximal to elongated discharge port into engagement with the ramp and slidably move the at least one solid marker body up the ramp and out of the discharge port in the delivery cannula into the biopsy cavity." (Emphasis added).

In rejecting claim 114, the Examiner recognizes that Foerster does not disclose aspects of the claimed invention relating to the recited ramp, for which the Examiner relies on Voegele. Applicants further submit that Fulton also does not disclose any structure relating to the recited ramp/plunger arrangement as recited in claim 114.

As illustrated in Foerster Figs. 5, 6, 7 and 8, Foerster discloses the deployment of a tissue marker along the axis of the needle lumen into the tissue 51 that was received through the side port of the needle, without the marker being expelled from the side opening to effect the marker deployment. Also, Fulton discloses in the sequence of Figs. 3, 4, and 5, that after the biopsy is taken and the biopsy needle 12 is removed, a bioabsorbable element 34 is deployed axially from the distal tip of the barrel 30. Thus, neither Foerster nor Fulton would benefit from the inclusion of a ramp within the distal shaft portion of the delivery cannula, as recited in claim 114.

Moreover, and in particular, the Examiner relies on Voegele column 8, line 65-column 9, line 2 (Figs. 1, 2, 5, 7, 8, 13, 17, 18, 19) and column 9, line 63-column 10, line 4 (Figs. 20-28). While Voegele discloses a ramp 65, the ramp is positioned to guide the distal edge 62 of the ferrule 34 to slide on the ramp so that the distal end of the flexible tube protrudes from the distal end of the egress tube. (Voegele column 10, lines 1-4). Also, in Voegele, a clip-shaped marker element is mounted to the distal end of the flexible tube and the clip-shaped marker element is operated between an opened and closed position by movement of the clip-shaped marker element relative to the ferrule 34. Moreover, the device of Voegele is configured for the deployment of only a single clip-shaped marker element, and cannot facilitate a plurality of solid markers.

Thus, none of Foerster, Voegele, and Fulton disclose, teach or suggest a configuration wherein a plunger is slidably disposed in part within the inner lumen of the delivery cannula proximal to the at least one solid marker body and detached from the at least one solid marker body, the plunger having a distal end configured to slidably engage and advance the at least one solid marker body from the location proximal to elongated discharge port into engagement with the ramp and slidably move the at least one solid marker body up the ramp and out of the discharge port in the delivery cannula into the biopsy cavity, as recited in claim 114.

In view of the above, it is respectfully submitted that all limitations of claim 114 are not found in the cited references, taken alone or in combination. "To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). As the Board of Patent Appeals and Interferences has held:

> "When determining whether a claim is obvious, an examiner must make "a searching comparison of the claimed invention – *including all its limitations* – with the teaching of the prior art." *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (emphasis added). Thus, "obviousness requires a suggestion of all limitations in a claim." *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) (*citing In re Royka*, 490 F.2d 981, 985 (CCPA 1974)). *Ex parte Wada, et al.*, Appeal 2007-3733 (SN 10/613,220, p. 7 (BPAI 2008) (emphasis in original).

Further, the necessary presence of all claim limitations is axiomatic, since the Supreme Court has long held that obviousness is a question of law based on underlying factual inquiries, including … ascertaining the differences between *the claimed invention* and the prior art. *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966) (emphasis added).

Accordingly, for at least the reasons set forth above, it is respectfully submitted that claim 114 is patentable in its present form.

Further, because the construction and operational principles of Voegele facilitate the deployment of only a single clip-shaped marker that is attached to the distal end of the elongated flexible tube 37 and with the clip-shaped marker element being operated between an opened and closed position by movement of the clip-shaped marker element relative to the ferrule 34, one skilled in the art would not be motivated to combine the disclosure of Voegele with the other cited references in an attempt to achieve the present invention, as recited in claim 114.

In addition, even if Foerster in view of Voegele and Fulton were combined, their combination would not yield the structure of the present invention or render it obvious. To achieve the invention as recited in claim 114 by the combination of Foerster in view of Voegele and Fulton, significant change in the structure and function of the combined elements of Foerster in view of Voegele and Fulton would have been required. Thus, for reasons set forth above, the improved structure provided by the present invention over that of Foerster in view of Voegele and Fulton is more than the predictable use of the elements of Foerster in view of Voegele and Fulton according to their established functions. See *KSR International Co. v. Teleflex Inc. (KSR)*, 127 S. Ct. 1727, 82 USPQ2d 1385, 1396 (2007).

Accordingly, for at least the reasons set forth above, it is respectfully submitted that independent claim 114 is patentable in its present form.

Claims 68, 69, 71, 113, and 116 depend, directly or indirectly, from claim 114, and thus are patentable for at least the reasons set forth above with respect to claim 114.

In addition, claims 68, 69, 71, 113, and 116 further and patentably define the invention over the cited references.

For example, claim 113 recites, "The system of claim 114 wherein the at least one solid marker body is at least five marker bodies that are slidably disposed within the inner lumen of the delivery cannula proximal to the elongated discharge port."

Because the construction and operational principles of Voegele facilitate the deployment of only a single clip-shaped marker that is attached to the distal end of the elongated flexible tube 37 and with the clip-shaped marker element being operated between an opened and closed position by movement of the clip-shaped marker element relative to the ferrule 34, one skilled in the art would not be motivated to combine the disclosure of Voegele with the other cited references in an attempt to achieve the present invention, as recited in claim 113, which expressly recites "at least five marker bodies that are slidably disposed within the inner lumen of the delivery cannula proximal to the elongated discharge port."

Accordingly, for at least the reasons set forth above, it is respectfully submitted that claim 113 is patentable in its own right.

Therefore, for at least the reasons set forth above, it is respectfully submitted that claims 68, 69, 71, 113, 114 and 116 are patentable under 35 U.S.C. §103(a) over Foerster in view of Voegele and Fulton.

Claims 73-75, 85 and 86 were rejected under 35 U.S.C. §103(a) as being unpatentable over Foerster in view of Voegele and Fulton, and further in view of Sirimanne, et al. (US 6,356,752 (sic., 6,356,782); hereinafter Sirimanne).

In this rejection, it appears the Examiner inadvertently misidentified the patent number of Sirimanne as being 6,356,752, rather than as US 6,356,782. US 6,356,752 was briefly reviewed, and it does not appear to be relevant to the prosecution of the present application. Accordingly, it is assumed that the Examiner intended the rejection to be based on of Sirimanne, et al. (US 6,356,782)

Claims 73-75, 85 and 86 depend, directly or indirectly, from claim 114, and thus are patentable for at least the reasons set forth above with respect to claim 114, since Sirimanne does not overcome the deficiencies of Foerster in view of Voegele and Fulton with respect to claim 114.

In addition, claims 73-75, 85 and 86 further and patentably define the invention over the cited references.

Therefore, for at least the reasons set forth above, it is respectfully submitted that claims 73-75, 85 and 86 are patentable under 35 U.S.C. §103(a) over Foerster in view of Voegele and Fulton, and further in view of Sirimanne.

Claims 76-84 were rejected under 35 U.S.C. §103(a) as being unpatentable over Foerster in view of Voegele and Fulton, and further in view of Yamamoto (US 4,847,049) as evidenced by Ronan, et al. (US 5,820,918; hereinafter Ronan).

Claims 76-84 depend, directly or indirectly, from claim 114, and thus are patentable for at least the reasons set forth above with respect to claim 114, since Yamamoto as evidenced by Ronan does not overcome the deficiencies of Foerster in view of Voegele and Fulton with respect to claim 114.

In addition, claims 76-84 further and patentably define the invention over the cited references.

For example, each of claims 81-84 recite a respective limitation of the at least one solid marker body in terms of its Bloom strength. For example, claim 81 recites a Bloom strength of at least 150; claim 82 recites a Bloom strength of not more than 300; claim 83 recites a Bloom strength of about 200 about 300, and claim 84 recites a Bloom strength of about 250 to about 300.

As set forth in Applicants' published specification (2004/0101479) at paragraph 0035:

> As is known, the firmness or bodily integrity of gelatin is measured in units of Bloom. Generally speaking **it was found** in accordance with the present invention that the higher the Bloom strength of the gelatin used in the marker 20 the better the marker performs. The higher Bloom strength gelatin holds gas bubbles within its matrix better than lower Bloom strength gelatin. Gelatin with a Bloom strength of approximately 150 especially 175 is adequate for the practice of the present invention, but a more preferred range is 200 to 300 Bloom, the most preferred range being between 250 and

> 300. (For comparison, typical food gelatin is approximately 75 Bloom, and gelatin of 300 Bloom feels like a soft rubber eraser.)" (Emphasis added).

The Examiner recognizes that none of the cited references discloses the recited ranges of Bloom strength, nor has the Examiner shown that the markers of the cited references would inherently fall within the recited Bloom strength ranges. As such, it is respectfully submitted that the Examiner has not established a prima facie case of obviousness with respect to claims 81-84.

Therefore, for at least the reasons set forth above, it is respectfully submitted that claims 76-84 are patentable under 35 U.S.C. §103(a) over Foerster in view of Voegele and Fulton, and further in view of Yamamoto as evidenced by Ronan.

Claims 111 and 112 were rejected under 35 U.S.C. §103(a) as being unpatentable over Foerster in view of Voegele and Fulton, and further in view of Li (US 6,350,274).

Claims 111 and 112 depend from claim 114, and thus are patentable for at least the reasons set forth above with respect to claim 114, since Li does not overcome the deficiencies of Foerster in view of Voegele and Fulton with respect to claim 114.

In addition, claims 111 and 112 further and patentably define the invention over the cited references.

For example, claim 111 recites, "The system of claim 114 wherein the at least one solid marker body has a transverse dimension of 1 to 3 mm." As to the specific subject matter recited in claim 111, the Examiner relies on Li column 8, lines 27-39 for disclosing a mold in which the diameter (width)" is about 3mm to about 15 mm. Thus, the transverse dimension range disclosed in Li is different than the recited range, with the Li width transverse dimension only touching to the upper end of the range.

Accordingly, claim 111 is patentable in its own right.

Therefore, for at least the reasons set forth above, it is respectfully submitted that claims 111 and 112 are patentable under 35 U.S.C. §103(a) over Foerster in view of Voegele and Fulton, and further in view of Li.

Claim 115 was rejected under 35 U.S.C. §103(a) as being unpatentable over Foerster in view of Voegele and Fulton, and further in view of Ronan.

Claim 115 depends from claim 114, and thus is patentable for at least the reasons set forth above with respect to claim 114, since Ronan does not overcome the deficiencies of Foerster in view of Voegele and Fulton with respect to claim 114.

Therefore, for at least the reasons set forth above, it is respectfully submitted that claim 115 is patentable under 35 U.S.C. §103(a) over Foerster in view of Voegele and Fulton, and further in view of Ronan.

Claims 68, 69, 71, 73-75, 85, 86, 113, 114 and 116 were rejected under 35 U.S.C. §103(a) as being unpatentable over Foerster in view of Voegele, et al. and Sirimanne. It appears that in this rejection the Examiner has misidentified the patent number of Sirimanne, which is US 6,356,782.

In rejecting claims 68, 69, 71, 73-75, 85, 86, 113, 114 and 116, the Examiner substitutes Sirimanne for Fulton, in comparison to the first rejection of claims 68, 69, 71, 113, 114 and 116 under 35 U.S.C. §103(a) set forth above. Like Fulton, the marker introducer of Sirimanne does not disclose a tubular structure having an elongated discharge port. (See Sirimanne Figs. 4A-4L and 5B-5E).

Notwithstanding, to insure complete consideration of the rejections based on Sirimanne, Applicants' arguments relating to 68, 69, 71, 73-75, 85, 86, 113, 114 and 116 follows.

Independent claim 114 recites, in part, "a delivery cannula having … a ramp within the distal shaft portion which is upwardly inclined to a distal portion of the elongated discharge port; b) at least one solid marker body slidably disposed within the inner lumen of the elongated shaft …; and c) a plunger which is slidably disposed in part within the inner lumen of the delivery cannula proximal to the at least one solid marker body and detached from the at least one solid marker body, the plunger having a distal end configured to slidably engage and advance the at least one solid marker body from the location proximal to elongated discharge port into engagement with the ramp and slidably move the at least one solid marker body up the ramp and out of the discharge port in the delivery cannula into the biopsy cavity." (Emphasis added).

In rejecting claim 114, the Examiner recognizes that Foerster does not disclose aspects of the claimed invention relating to the recited ramp, for which the Examiner relies on Voegele. Applicants further submit that Sirimanne also does not disclose any structure relating to the recited ramp/plunger arrangement as recited in claim 114.

As illustrated in Foerster Figs. 5, 6, 7 and 8, Foerster discloses the deployment of a tissue marker along the axis of the needle lumen into the tissue 51 that was received through the side port of the needle, without the marker being expelled from the side opening to effect the marker deployment. Also, Sirimanne discloses in the sequence of Figs. 4A-4L, that after the biopsy is taken and the biopsy needle is removed, a marking device 402 is deployed axially from the distal tip of the access device 400. Thus, neither Foerster nor Sirimanne would benefit from the inclusion of a ramp within the distal shaft portion of the delivery cannula, as recited in claim 114.

Moreover, and in particular, particular, the Examiner relies on Voegele column 8, line 65-column 9, line 2 (Figs. 1, 2, 5, 7, 8, 13, 17, 18, 19) and column 9, line 63-column 10, line 4 (Figs. 20-28). While Voegele discloses a ramp 65, the ramp is positioned to guide the distal edge 62 of the ferrule 34 to slide on the ramp so that the distal end of the flexible tube protrudes from the distal end of the egress tube. (Voegele column 10, lines 1-4). Also, in Voegele, a clip-shaped marker element is mounted to the distal end of the flexible tube and the clip-shaped marker element is operated between an opened and closed position by movement of the clip-shaped marker element relative to the ferrule 34. Moreover, the device of Voegele is configured for the deployment of only a single clip-shaped marker element, and cannot facilitate a plurality of solid markers.

Thus, none of Foerster, Voegele, and Sirimanne disclose, teach or suggest a configuration wherein a plunger is slidably disposed in part within the inner lumen of the delivery cannula proximal to the at least one solid marker body and detached from the at least one solid marker body, the plunger having a distal end configured to slidably engage and advance the at least one solid marker body from the location proximal to elongated discharge port into engagement with the ramp and slidably move the at least one solid marker body up the ramp and out of the discharge port in the delivery cannula into the biopsy cavity, as recited in claim 114.

In view of the above, it is respectfully submitted that all limitations of claim 114 are not found in the cited references, taken alone or in combination. "To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). As the Board of Patent Appeals and Interferences has held:

> "When determining whether a claim is obvious, an examiner must make "a searching comparison of the claimed invention – *including all its limitations* – with the teaching of the prior art." *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (emphasis added). Thus, "obviousness requires a suggestion of all limitations in a claim." *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) (*citing In re Royka*, 490 F.2d 981, 985 (CCPA 1974)). *Ex parte Wada, et al.*, Appeal 2007-3733 (SN 10/613,220, p. 7 (BPAI 2008) (emphasis in original).

Further, the necessary presence of all claim limitations is axiomatic, since the Supreme Court has long held that obviousness is a question of law based on underlying factual inquiries, including ... ascertaining the differences between *the claimed invention* and the prior art. *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966) (emphasis added).

Accordingly, for at least the reasons set forth above, it is respectfully submitted that claim 114 is patentable in its present form.

In addition, because the construction and operational principles of Voegele facilitate the deployment of only a single clip-shaped marker that is attached to the distal end of the elongated flexible tube 37 and with the clip-shaped marker element being operated between an opened and closed position by movement of the clip-shaped marker element relative to the ferrule 34, one skilled in the art would not be motivated to combine the disclosure of Voegele with the other cited references in an attempt to achieve the present invention, as recited in claim 114.

Thus, even if Foerster in view of Voegele and Sirimanne were combined, their combination would not yield the structure of the present invention or render it obvious. To achieve the invention as recited in claim 114 by the combination of Foerster in view of

Voegele and Sirimanne, significant change in the structure and function of the combined elements of Foerster in view of Voegele and Sirimanne would have been required. Thus, for reasons set forth above, the improved structure provided by the present invention over that of Foerster in view of Voegele and Sirimanne is more than the predictable use of the elements of Foerster in view of Voegele and Sirimanne according to their established functions. See *KSR International Co. v. Teleflex Inc. (KSR)*, 127 S. Ct. 1727, 82 USPQ2d 1385, 1396 (2007).

Accordingly, for at least the reasons set forth above, it is respectfully submitted that independent claim 114 is patentable in its present form.

Claims 68, 69, 71, 73-75, 85, 86, 113, and 116 depend, directly or indirectly, from claim 114, and thus are patentable for at least the reasons set forth above with respect to claim 114.

In addition, claims 68, 69, 71, 73-75, 85, 86, 113, and 116 further and patentably define the invention over the cited references.

For example, claim 113 recites, "The system of claim 114 wherein the at least one solid marker body is at least five marker bodies that are slidably disposed within the inner lumen of the delivery cannula proximal to the elongated discharge port."

Because the construction and operational principles of Voegele facilitate the deployment of only a single clip-shaped marker that is attached to the distal end of the elongated flexible tube 37 and with the clip-shaped marker element being operated between an opened and closed position by movement of the clip-shaped marker element relative to the ferrule 34, one skilled in the art would not be motivated to combine the disclosure of Voegele with the other cited references in an attempt to achieve the present invention, as recited in claim 113, which expressly recites "at least five marker bodies that are slidably disposed within the inner lumen of the delivery cannula proximal to the elongated discharge port."

Accordingly, for at least the reasons set forth above, it is respectfully submitted that claim 113 is patentable in its own right.

Therefore, for at least the reasons set forth above, it is respectfully submitted that claims 68, 69, 71, 73-75, 85, 86, 113, 114 and 116 are patentable under 35 U.S.C. §103(a) over Foerster in view of Voegele and Sirimanne.

Claims 76-84 were rejected under 35 U.S.C. §103(a) as being unpatentable over Foerster in view of Voegele and Sirimanne, and further in view of Yamamoto as evidenced by Ronan.

Claims 76-84 depend, directly or indirectly, from claim 114, and thus are patentable for at least the reasons set forth above with respect to claim 114, since Yamamoto as evidenced by Ronan does not overcome the deficiencies of Foerster in view of Voegele and Sirimanne with respect to claim 114.

In addition, claims 76-84 further and patentably define the invention over the cited references.

For example, each of claims 81-84 recite a respective limitation of the at least one solid marker body in terms of its Bloom strength. For example, claim 81 recites a Bloom strength of at least 150; claim 82 recites a Bloom strength of not more than 300; claim 83 recites a Bloom strength of about 200 about 300, and claim 84 recites a Bloom strength of about 250 to about 300.

As set forth in Applicants' published specification (2004/0101479) at paragraph 0035:

> As is known, the firmness or bodily integrity of gelatin is measured in units of Bloom. Generally speaking **it was found** in accordance with the present invention that the higher the Bloom strength of the gelatin used in the marker 20 the better the marker performs. The higher Bloom strength gelatin holds gas bubbles within its matrix better than lower Bloom strength gelatin. Gelatin with a Bloom strength of approximately 150 especially 175 is adequate for the practice of the present invention, but a more preferred range is 200 to 300 Bloom, the most preferred range being between 250 and 300. (For comparison, typical food gelatin is approximately 75 Bloom, and gelatin of 300 Bloom feels like a soft rubber eraser.)" (Emphasis added).

The Examiner recognizes that none of the cited references discloses the recited ranges of Bloom strength, nor has the Examiner shown that the markers of the cited references would inherently fall within the recited Bloom strength ranges. As such, it is respectfully submitted that the Examiner has not established a prima facie case of obviousness with respect to claims 81-84.

Therefore, for at least the reasons set forth above, it is respectfully submitted that claims 76-84 are patentable under 35 U.S.C. §103(a) over Foerster in view of Voegele and Sirimanne, and further in view of Yamamoto as evidenced by Ronan.

Claims 111 and 112 were rejected under 35 U.S.C. §103(a) as being unpatentable over Foerster in view of Voegele and Sirimanne, and further in view of Li.

Claims 111 and 112 depend from claim 114, and thus are patentable for at least the reasons set forth above with respect to claim 114, since Li does not overcome the deficiencies of Foerster in view of Voegele and Sirimanne with respect to claim 114.

In addition, claims 111 and 112 further and patentably define the invention over the cited references.

For example, claim 111 recites, "The system of claim 114 wherein the at least one solid marker body has a transverse dimension of 1 to 3 mm." As to the specific subject matter recited in claim 111, the Examiner relies on Li column 8, lines 27-39 for disclosing a mold in which the diameter (width)" is about 3mm to about 15 mm. Thus, the transverse dimension range disclosed in Li is different than the recited range, with the Li width transverse dimension only touching to the upper end of the range.

Accordingly, claim 111 is patentable in its own right.

Therefore, for at least the reasons set forth above, it is respectfully submitted that claims 111 and 112 are patentable under 35 U.S.C. §103(a) over Foerster in view of Voegele and Sirimanne, and further in view of Li.

Claim 115 was rejected under 35 U.S.C. §103(a) as being unpatentable over Foerster in view of Voegele and Sirimanne, and further in view of Ronan.

Claim 115 depends from claim 114, and thus is patentable for at least the reasons set forth above with respect to claim 114, since Ronan does not overcome the deficiencies of Foerster in view of Voegele and Sirimanne with respect to claim 114.

Therefore, for at least the reasons set forth above, it is respectfully submitted that claim 115 is patentable under 35 U.S.C. §103(a) over Foerster in view of Voegele and Sirimanne, and further in view of Ronan.

In the Remarks at page 35 of the present Office Action, the Examiner asserts that one cannot show non-obviousness by attacking the references individually. Throughout this and prior office actions, the Examiner asserts individual references to attack particular aspects of the recited claim limitations. It is respectfully submitted that at least with respect to the present Amendment, any perceived attack on individual references is to show that the

Examiner has either misinterpreted or misapplied the cited references, such that the Examiner has not established a prima facie case of obviousness, in which case the burden has not shifted to Applicants to establish a negative, i.e., show non-obviousness.

For example, "To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). As the Board of Patent Appeals and Interferences has held:

> "When determining whether a claim is obvious, an examiner must make "a searching comparison of the claimed invention – *including all its limitations* – with the teaching of the prior art." *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (emphasis added). Thus, "obviousness requires a suggestion of all limitations in a claim." *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) (*citing In re Royka*, 490 F.2d 981, 985 (CCPA 1974)). *Ex parte Wada, et al.*, Appeal 2007-3733 (SN 10/613,220, p. 7 (BPAI 2008) (emphasis in original).

For the foregoing reasons, Applicants believe that the present application is in condition for allowance in its present form, and it is respectfully requested that the Examiner so find and issue a Notice of Allowance in due course.

In the event Applicants have overlooked the need for an extension of time, an additional extension of time, payment of fee, or additional payment of fee, Applicants hereby conditionally petition therefor and authorize that any charges be made to Deposit Account No. 50-5242, RONALD K. AUST, P.C.

Should any question concerning any of the foregoing arise, the Examiner is invited to telephone the undersigned at (317) 894-0801.

Respectfully submitted,

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